

16 JUN 2005

#9



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Michael A. Steinberg, Ph.D.  
IVAX Corporation  
4400 Biscayne Boulevard  
Miami, FL 33137

In re Application of  
Barta, et al.  
Serial No.: 10/088,989  
PCT No.: PCT/HU00/00099  
Int. Filing Date: 23 September 2000  
Priority Date: 23 September 1999  
Attorney's Docket No.: IDR0242-USA  
For: PROCESS FOR THE PREPARATION OF  
MYCOPHENOLIC ACID AND  
DERIVATIVES THEREOF

DECISION ON  
PETITION  
UNDER 37 CFR 1.137(b)

This decision is responsive to the "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)" filed 14 December 2004.

**BACKGROUND**

On 22 September 2000, applicants filed international application PCT/HU00/00099, which claimed priority of an earlier Hungarian application filed 23 September 1999. On 22 March 2001, a Demand (form PCT/IPEA/401) for International Preliminary Examination was filed. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 23 March 2002.

On 23 March 2002, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a copy of the international application and authorization to charge the basic national fee. These papers were assigned Application No. 10/088,989.

On 22 July 2002, the United States Patent and Trademark mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and additional claim fees. The notification set a two-month time period in which to respond.

On 19 November 2002, applicant filed the executed declarations along with authorization to charge the deposit account for the extra claim fees.

On 17 January 2003, the United States Patent and Trademark mailed the "NOTIFICATION OF DEFECTIVE RESPONSE" (form PCT/DO/EO/916) indicating that the declaration was not executed by inventor Antonia Jekkel. The notification set a one-month time period in which to respond.

On 12 December 2003, the United States Patent and Trademark mailed the "NOTIFICATION OF ABANDONMENT" (form PCT/DO/EO/909) indicating that the application had become abandoned for failure to respond to the form PCT/DO/EO/916.

On 13 December 2004, applicant filed the current petition to revive along with a declaration executed by all of the inventors.

### DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied (1) by a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," (2) by a proper reply, (3) by the petition fee required by law (37 CFR 1.17(m)), and (4) if the international filing date of the application is before June 8, 1995, any petition to revive under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer and small entity fee of \$55

Applicants have provided the required statement and the petition fee.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Applicant's declaration filed with this petition is improper because applicant is required to state the citizenship, residence and mailing address of the legal representative, as well as that of the deceased inventor. Therefore, applicant has not filed a proper response.

Further, 37 CFR 1.52(c)(1) states:

Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

Corrections have been made in the signature boxes of both inventor Antal Szabo and inventor Istvan Mhaly Szabo. These corrections have not been initialed and dated. It is not clear if these corrections were made before or after the declarations were signed. A new declaration is required.

### CONCLUSION

The petition to revive the application abandoned under 35 U.S.C. 1.137(b) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Debra Brittingham  
Office of PCT Legal Administration  
DSB/BM:dsb



Boris Milef  
PCT Legal Examiner  
Office of PCT Legal Administration

Tel: (571) 272-3280  
Fax: (571) 273-0459